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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,093	06/20/2003	Kaoru Haruna	FY.50639US0A	9756

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EXAMINER

FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/601,093	HARUNA ET AL.	
	Examiner	Art Unit	
	Bryan Fischmann	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17 and 22-25 is/are allowed.
- 6) ☒ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03-23-05</u> | 6) <input type="checkbox"/> Other: _____ |

Acknowledgements

1. The amendment filed 03-23-2005 has been entered.

Specification

2. The specification is objected to because of the following:

A) The following recited phrases are unclear, awkwardly worded, and/or grammatically incorrect:

1) To be grammatically correct, the first instance of the recitation of "fastener" on the penultimate line of paragraph 0032 should instead be the plural "fasteners".

Claim Objections

3. Claim 18 is objected to because of the following:

A) Claim 18 recites "the snow" on line 3. Line 6 of claim 18 then recites "the snow surface". Accordingly, to be "consistent" with line 6, it is believed the above line 3 recitation should instead read "a snow surface".

B) The penultimate line of claim 18 recites "a wear bar". Since the previous line of claim 18 recites "a wear bar", it is believed that the above recitation should instead read "the wear bar".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 18, as amended, recites "...a ski mounting bracket...the ski mounting bracket defining...a pivot point...a wear bar...and means for preventing a wear bar from entering depressions in the snow surface, said means being positioned entirely either forward or rearward of the bracket pivot point".

This recitation is considered to contain new matter due to the following:

A) Support for the above recitation is found in paragraph 0036 of the specification, which recites "...In addition, incorporating the glide member can improve steering and handling of the snowmobile 10 by preventing the wear bar from entering snow tracks from other snowmobile skis. Snow tracks from other snow vehicles can be more pronounced in icy environments leading to more difficult handling conditions. The glide member 270 prevents the wear bar 154 and, in some instances, the ski 100 from entering snow tracks from other snowmobile skis formed in icy environments".

B) From the above, it is best understood that only "forward glide member 270" prevents wear bar 154 from entering tracks or depressions formed in a snow surface". The forward glide member 270 is understood to be structure corresponding to the phrase "means for preventing a wear bar from entering depressions in the snow

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surface" recited above. There is no original disclosure that can be found that "rear guide member 294" by "itself" would prevent the wear bar from entering tracks and depressions.

Due to this, the above claim 18 recitation, which includes amended limitations, is considered new matter.

Per Section 2163.06 of the MPEP, new matter in the claims should be rejected under 35 USC 112 first paragraph, written description requirement.

Also note that it is believed that to "prevent" the entire length of the wear bar from entering depressions in the snow surface, that, contrary to the above, that both the forward and rear gliding members, 270 and 294 would be required to be installed. This is not consistent with the claim 18 language above.

Additionally, note that the latter paragraph of paragraph 0041 recites "...At least a portion of the glide member 270 is disposed below the wear bar 154 and helps keep the wear bar 154 from entering ruts and tracks formed by other snow vehicles".

This paragraph 0041 recitation teaches that the forward glide member only "helps keep the wear bar 154 from entering ruts and tracks formed by other snow vehicles". This would apparently mean that "other structure" in addition to the forward glide member 270 is required in order to "prevent" the wear bar from entering "depressions". Note also that the portion of paragraph 0041 recited above would appear to contradict the portion of paragraph 0036 recited above.

For purposes of examination, based on originally disclosed paragraph 0036 and the above, it will be assumed that only "means" forward of the bracket pivot means will

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prevent at least the forward portion of the wear bar from entering depressions in the snow surface.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 18-20, as best understood (see 112 1st rejection), are rejected under 35 U.S.C. 102(e) as being anticipated by Moriyama, et al, US Patent 6,513,612.

Moriyama teaches a snowmobile comprising an engine (20), a transmission (line 46 of column 3), a drive track (44), a steering mechanism (including 26), and a ski (30),

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the ski having ski body with a generally horizontal bottom surface that contacts a snow surface when the ski is in use, a ski mounting bracket (52) located on a top side of the ski body, the ski mounting bracket defining at least in part a pivot point (60), a wear bar (56 – rear portion – see Figure 2 and 112 1st rejection) extending below the bottom surface of the ski body, and means (including 106, 114 and 116) for preventing a wear bar (56 – front portion – see Figure 2 and 112 1st rejection) from entering depressions in the snow surface, said means being positioned entirely either forward (selected) or rearward (not selected) of the bracket pivot point.

Regarding claim 20, note that by adjusting 106, 114 and 116, which are located several places along the ski length (see Figure 2), that the rearward portion of the wear bar may also be positioned “further upward”, along with, or in place of the frontward portion.

Allowable Subject Matter

8. Claims 1-17 and 22-25 are allowed.

Examiner's Comments

9. The amendments to independent claims 1 and 12 have overcome the 102 and 103 rejections of these claims set forth in the last Office Action dated 11-23-2004.
10. The Applicant's comments in the “Remarks” portion have been considered.

Conclusion

11. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dick, et al, Bergstrom – teach snowmobile skis

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (571) 272-6694. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

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If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5-10-5
BRYAN FISCHMANN
PRIMARY EXAMINER